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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/780,743

02/19/2004

Hideyuki Yanami

KAS-199

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01/08/2008

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.

1800 DIAGONAL ROAD

SUITE 370

ALEXANDRIA, VA 22314

EXAMINER

WRIGHT, PATRICIA KATHRYN

ART UNIT

PAPER NUMBER

1797

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/780,743

Applicant(s)

YANAMI ET AL.

Examiner

P. Kathryn Wright

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This action is in response to papers filed October 18, 2007 in which claims 1-8 were canceled and claims 9-19 were added. The amendments have been thoroughly reviewed and entered.

New grounds for rejection, necessitated by the amendments, are discussed. Any objection/ rejection not repeated herein has been withdrawn by the Examiner.

Claims 9-19 are under prosecution.

Information Disclosure Statement

2. As discussed in the previous action, the information disclosure statement filed October 07, 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it does not provide a translation of reference no EPO 601213, which is in a non-English language (German). Nor does the specification discuss the relevance of the aforementioned reference. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Drawings

3. The drawings are again objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Specifically, the "sample surface level detecting function" recited in newly added claims 11 and 17, and the "nozzle clogging function" in new claims 12 and 18. Neither of these claimed features are illustrated in any of the Figures. These elements must be shown or canceled from the claims. No new matter should be entered.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. New claims 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of independent claim 15 recites a "sample dispensing method...comprising the steps of". This is confusing and indefinite since claims 16-19, which depend from claim 15, recite sample dispensing apparatus in the preamble, not a method. It appears applicant has mixed the two classes of invention (apparatus and method) in the claims. Since two separate statutory type claims are combined into the claims, it is not clear as to which type of claim is being presented (i.e., method or apparatus).

Furthermore, claim 16 recites "wherein said movement in said closed loop is substantially an elliptic shape..." This is confusing and indefinite since it is not clear how the movement can be defined by a shape.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 9-10, 13-16 and 19 are now rejected under 35 U.S.C. 102(b) as being anticipated by Itoh (US Patent no. 5,445,037).

Itoh teaches the sample dispensing apparatus and method of operating the same substantially as claimed. The Itoh apparatus includes a plurality of probes, each probe includes a probe head 32 and 38 with nozzles 33, 39 for aspirating and discharging the sample. The plurality of nozzles being movable to aspirate and discharge the sample independently of each other. The apparatus of Itoh includes rails 31 and 37 that the sample probe heads 32, 38 are mounted on, respectively (see col. 3, lines 5-67 and Fig. 1). As shown Fig. 1, the rails 31 and 37 are attached together at either end by transverse support members (no reference nos.), thereby forming a closed "loop". The analyzer system of Itoh also includes a controller 100 for controlling the probes independently so that they can reciprocally move between a sample suction position and a sample discharge position (see col. 6, line 62+). That is, the controller can operate the probe heads 32, 38 sequentially or simultaneously (see col. 7, line 55 et seq).

Regarding claims 10 and 16, the rails 31 and 37 are attached together at either end by transverse support members, thus the closed "loop" in the form of a rectangular shape as seen from above, see Fig. 1.

With respect to claims 13 and 19, the controller can operate the probes independently (simultaneously or sequentially); thus, it is inherent that one of the probes can be stopped while the other continues to operate.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 11-12 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh (US Patent no. 5,445,037) in view of Babson et al. (US Patent no. 5,885,530), hereinafter Babson.

The teachings of Itoh have been summarized previously, supra. Itoh does not explicitly teach the sample probes including a sample surface level detecting function for detecting the level of the sample and transmitting the detected level to the controller (claims 11 and 17), or the sample probes including a nozzle clogging detecting function that transmits detection of a clog to the controller (claims 12 and 18).

Babson teaches an analyzer system 10 including a fluid dispensing apparatus. The fluid dispensing mechanism is for aspirating the sample from the sample container at

a particular location in the carousel and discharging the aspirate into the reaction cuvette at station 204. The sample dispensing apparatus includes a plurality of nozzles 205, 206 for aspirating and discharging the fluid. The analyzer system of Babson includes a computer 12 that controls the nozzles individually. Babson also teaches at least one nozzle 206 having a liquid level detecting function for detecting the surface level of the fluid in the container and transmitting the detected level to the computer (see col. 6, lines 20-25.) Furthermore, Babson teaches a clot detection apparatus (see col. 6, lines 41-46). Clots naturally agglomerate. This can result in clogs in the flow passage of the nozzle. Thus, the clot detecting apparatus of Babson is capable of detecting clogs therein.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in Itoh, the liquid level detecting function of Babson in order to reduce the quantity of the liquid adhered to an outer wall of the probe which, in turn, reduces the likelihood of cross-contamination between fluid containers. Similarly, one of ordinary skill in the art at the time of the claimed invention would have been motivated to include the clot detection function of Babson, in the analyzer system of Itoh, in order to ensure the probe remains working properly should it become clogged.

Response to Arguments

12. Applicant's arguments filed October 18, 2007 have been fully considered but they are not persuasive.

With respect to the previous objection to the drawings under 37 CFR 1.83(a), Applicant states that the specification describes the sample probes having a liquid level function and a clogging detection function and since these functions are shown as part of the sample probes themselves, illustration of these functions are not required.

The Examiner respectfully disagrees with Applicant's assertion. The fact that they are described functionally in the specification is not sufficient according to 37 CFR 1.83(a), which clearly states that the drawings **must show every feature of the invention specified in the claims**. Thus, the "sample surface level detecting function" in newly added claims 11 and 17, and the "nozzle clogging function" in new claims 12 and 18 must be shown or canceled from the claims. No new matter should be entered.

Regarding the previous rejection of claims 1-2, 4 and 7-8 under 35 U.S.C. 102(b) as being anticipated by Itoh (US Patent no. 5,445,037), Applicant admits the pair of probes in Itoh can be reciprocated respectively. However, Applicant argues that the Itoh reference fails to show certain features of applicant's invention, i.e., the parent sample containing bodies 10 and child sample containing bodies 20 are moved in each reciprocation motion of the distributing head. From this Applicant concludes the one sample and one parent sample containing body is sucked and discharged to one child sample containing body, and is not discharged to another child sample containing body 20.

The Examiner respectfully disagrees with Applicant's assertions. In response to Applicant's argument that the Itoh reference fails to show certain features of applicant's invention, the Examiner notes that the features upon which applicant relies (i.e., child

and parent containers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

13. No claims allowed.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is 571-272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pkw


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